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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/872,640

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Motasim Sirhan

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01/30/2004

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EXAMINER

THALER, MICHAEL H

ART UNIT

PAPER NUMBER

3731

DATE MAILED: 01/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/872,640

Applicant(s)

SIRHAN ET AL.

Examiner

Michael Thaler

Art Unit

3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-9,11-13,15-19,22-45 and 47-52 is/are pending in the application.
- 4a) Of the above claim(s) 11,13,26-36,38-45 and 47-52 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-9,12,15-19,22-25 and 37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 10. 6) ☐ Other: _____

Art Unit: 3731

Applicant's election with traverse of Group I and species C (Figures 5A, 5B and 13A) in Paper No. 12 and 18 is acknowledged. The traversal in Paper No. 12 is on the ground(s) that claims 38, 40, 41, 44, 45 and 49-51 have been amended to recite "body lumen" instead of "blood vessel". This is not found persuasive because the product as claimed (Group I) could still be used in a process which is materially different than the process of Group II. For example, it could be used without replacing or exchanging the balloon. The requirement is still deemed proper and is therefore made FINAL.

Claims 11, 13, 26-36, 38-45 and 47-52 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species and invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 12. Contrary to applicant's remarks in Paper No. 18, claims 11 and 13 do not read on the elected species. Claim 11 depends on canceled claim 10 and the groove in the inflation tube defined in claim 11 is shown in the species of figure 3A rather than the elected species of figures 5A, 5B and 13A. Claim 13 is limited to the embodiment of figure 6-11 (wherein the catheter body has an inflation lumen which mates with an inflation port on the

Art Unit: 3731

balloon structure) rather than the elected species of figures 5A, 5B and 13A.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the oblong and elliptical shapes defined in claim 3 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claims 1, 3-9, 12, 15-19, 22-25 and 37 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The embodiment of figures 5A, 5B and 13A, as described in the specification and shown in the drawings, is inoperable. The distal end of inflation tube 26 is shown attached to the back end of inner sleeve 38 in figure 2. Although the inflation tube 26 is slidable within slit 24 since it has a cross-section which is smaller than the cross-section

Art Unit: 3731

of slit 24, the inner sleeve 38 (which is located relative to the inflation tube 26 as shown in figure 2) will not fit into slit 24. Since the wall of the inner sleeve 38 is located directly in line with the inflation tube 26 as shown in figure 2, the balloon structure 14 is not slidable relative to the catheter body 12 shown in figure 5A, 5B and 13A. If the inner sleeve 38 is located on the outer surface of catheter body 12, it is unclear what tube or other member connects the inflation tube 26 to the balloon. If there is such a tube, it appears that it must be smaller in diameter than the width of the narrow portion of slit 24 shown at the outer periphery of catheter body 12 shown in figure 13A (since it must pass radially outward from inflation tube 26 to the balloon through this portion of slit 24). Yet, no tube or its dimensions are disclosed.

Claim 37 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In line 2, "second catheter body" is confusing and inaccurate since the second balloon structure 14', according to the specification, is a balloon structure rather than a catheter body.

Claims 1, 3-9, 12, 15-19, 22-25 and 37 are free of any rejection based upon the prior art of record.


Art Unit: 3731

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Thaler whose telephone number is (703) 308-2981. The examiner can normally be reached Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael J. Milano can be reached on (703)308-2496. The fax phone number for the organization where this application or proceeding is assigned is (703)872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0858.

mht
1/28/04


MICHAEL THALER
PRIMARY EXAMINER
ART UNIT 3731